REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

By this Amendment, claims 1-4 are amended, and new claims 5-6 are added to secure an appropriate scope of protection to which Applicants are believed entitled. Accordingly, claims 1-6 are pending in this application.

Claim Rejections under 35 USC §112

The Patent and Trademark Office (PTO) rejects claim 4 under 35 U.S.C. §112, second paragraph, asserting that the claim is indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Applicants amend claim 4 to more clearly recite the claimed subject matter. This rejection is respectfully traversed.

Claim Rejections Under 35 USC §103(a)

Claims 1-3 stand rejected under 35 U.S.C. §103(a) over Weinstein (US 5,558,264) in view of Masahiro (JP 54136478). In response claims 1-3 are amended to merely more clearly recite the claimed subject matter and to place the application in better compliance with commonly accepted US patent practice. Applicants respectfully submit that, as presented below, the claims are patentable over the applied art for the failure of the applied art to not only disclose, teach or suggest all of Applicants' recited claim features, but in addition for failing to present any apparent reason to combine the references or modify the prior art to create the Applicants' allegedly obvious claim elements.

Whether or not the claimed subject matter would have been obvious at the time of invention to one of ordinary skill in the art is a question of law based on underlying facts. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 (Fed. Cir. 2000). The relevant factual inquiries include the following factors:

> (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations…. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

Here, many of these factual questions and the ultimate legal conclusion are in dispute. For example, Applicants dispute what the asserted prior art teaches, and more particularly, the Examiner's finding that:

> [i]n view of the teachings of JP '478, it would have been obvious to one skilled in the art to decouple the driving out mechanism from the nail feeding mechanism by using different driving sources which can be done by replacing the pneumatic piston (220) of Weinstein '264 with the electromagnetic piston (12, 13, 14) o fJP'478 in order to more effectively operate the tool.
>
> Office Action (OA) issued 04-29-2010, bottom of page 3.

Weinstein'264 at best discloses a combustion powered fastener-feeding mechanism, while *JP '478* appears to only disclose an electromagnetically actuated piston.

Claim 1 is patentable over the applied references based upon the failure of the Examiner to present any apparent reason to combine references or modify prior art to create the Appellants' allegedly obvious claim elements.

As stated in KSR Intl. Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007):

> [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Even if, as argued by the Examiner, one of ordinary skill in the art would have found it more effective to use an electric fastener-feeding mechanism in combination with a gas operated driving out mechanism, that argument is not sufficient for establishing a *prima facie* case of obviousness of the Appellants' claimed invention. The Examiner must provide the required

articulated reasoning with rational underpinning which shows that one of ordinary skill in the art would have been led by *JP '478* to replace the gas driven fastener-feeding mechanism of *Weinstein '264* with an electric fastener-feeding mechanism that results in the Appellants' claimed apparatus, and the Examiner has not done so. Nowhere does either reference suggest a problem with a single driving source whereby decoupling the driving out mechanism from the nail feeding mechanism by using different driving sources would be desirable.

As noted above, the Examiner erred in the factual inquiry into the four Graham factors and therefore the Examiner erred in making the ultimate finding of obviousness. For this reason, withdrawal of the rejection of claim 1 and claims 2-3 that depend therefrom, is respectfully requested.

Notwithstanding the indication that claim 4 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph, and to include all of the limitations of the base claim and any intervening claims, Applicants submit that amended claim 4 is allowable at least based upon its ultimate dependence on allowable claim 1, as well as for additional features it recites.

New Claims

New claims 5-6 are based upon claims 1 and 4 and are added to provide the Applicants with a scope of patent protection Applicants are believed entitled to.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

The Examiner is invited to telephone the undersigned attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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